

REMARKS

Applicant has studied the Office Communication dated December 16, 2003, and has made amendments to the specification. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Claim Rejections - 35 U.S.C. § 101

Claims 1-17 have been rejected under 35 U.S.C. § 101 because “the disclosed invention is inoperative and therefore lacks utility.” The Examiner stated that although the claims have been amended to remove language concerning the convergence of magnetic energy, the specification still discloses the only use of the reflector as for converging the magnetic energy.

Applicant respectfully submits the claimed invention is not inoperative and does not lack utility, as the Examiner asserts. Although the specification as filed disclosed that the use of the reflector was for converging magnetic energy to a focal point, the magnetic field generated by the magnet of the claimed apparatus provided magnetic energy for acupuncture therapy. The as filed specification and claims stated that the reflector enhanced the transmission of magnetic energy. The claimed invention, as amended, is described as a magnetic acupuncture apparatus comprising a structure having a parabolic reflector dish. Accordingly, the structure of the present invention operates as an acupuncture apparatus having a magnetic field for magnetic therapy. As described in the amended specification and recited in the previously amended claims, the present invention is therefore operative and does not lack utility.

Furthermore, it is submitted that the specification and abstract have been amended so that the claimed invention is properly disclosed in the specification. Particularly, language describing the reflector as converging magnetic energy or waves to a focal point has been deleted. Accordingly, the claimed invention, as recited, is adequately described in the specification. It is submitted that no new matter has been added with these amendments. Clean and marked up substitute specifications and abstracts, showing additions and deletions, have been provided to the Examiner for reference. Accordingly, it is respectfully submitted that claims 1-17 overcome the rejection under 35 U.S.C. § 101 and should be deemed allowed.

Claim Rejections - 35 U.S.C. § 112

Claims 1-17 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enabling requirement. The Examiner stated that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner further stated that although the language concerning the convergence of magnetic energy, the only disclosed use of the reflector is to focus the magnetic energy, which still makes the subject matter not being described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

When the scope of a claim has been changed by amendment in such a way as to justify an assertion that the scope is directed to an invention different from the original claim, the newly claimed subject matter should have been described in the application when filed. Under 35 U.S.C. § 132, “no amendment shall introduce new matter into the disclosure of the invention.” Furthermore, if the essence of the original disclosure supports the new claim limitation, the new limitation is not new matter. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989). To overcome a prima facie case of unpatentability with respect to new matter, an applicant must show that the invention as claimed is adequately described. *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996). An amendment cannot change the scope of the claim beyond that supported in the specification and cannot change the disclosure in a way contrary to its substance as filed. *Tandon Corp. v. United States ITC*, 831 F.2d 1017, 4 USPQ2d 1283 (Fed. Cir. 1987).

As stated above in the arguments with respect to the claim rejection under § 101, the use of the reflector was disclosed as to enhance the transmission of magnetic energy emanating from the magnet. Although no other uses for the reflector were disclosed, the specification of the claimed invention does not indicate the aforementioned use as the only use. It is submitted that that the essence of the as filed disclosure, *i.e.*, the recitation of the structure of the claimed invention, supports the previously amended claims. The claims were amended in the response to the previous response Office Action (Paper No. 3) to recite a structure comprising a reflector attached to a proximal end of the body. Therefore, it is respectfully submitted that the specification, as amended, adequately describes and supports the present invention as claimed and does not change the disclosure in a way contrary to its substance as filed. Accordingly, the

amended specification and claims do enable one skilled in the art to construct a magnetized acupressure apparatus comprising a reflector.

In view of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the rejections of claims 1-17 under § 112.

Conclusion

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,
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